



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,355	12/14/2001	David Spitz	9213-12	6838
20792	7590	03/24/2006	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC			TIEU, BINH KIEN	
PO BOX 37428			ART UNIT	
RALEIGH, NC 27627			PAPER NUMBER	
			2614	

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,355

Applicant(s)

SPITZ ET AL

Examiner

BINH K. TIEU

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-60 have been considered. The Applicants argued that Ferber reference and other cited references fails to clearly teach the feature of "registering users with a *specific identified* direct marketing campaign." (Emphasis added) The arguments are moot in view of the new ground(s) of rejection as followings.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2643

4. Claims 1, 6-9, 17-21, 26-29, 37-41, 46-49 and 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferber (Pub. No.: US 2001/0032193 A1 *as cited in the previous Office Action*) in view of Miller (U.S. Pat. #: 6,882,977).

Regarding claim 1, Ferber teaches a method of registering wireless device users in a direct marketing campaign, comprising: providing content within a display of a wireless device, wherein the content includes a portion that is responsive to user activation and that displays an identification of a direct marketing campaign, and wherein the content portion, responsive to user activation, is configured to register a user to receive one or more communications from the direct marketing campaign (paragraphs [0034] [0040]-[0041]); and obtaining user identification information and direct marketing campaign identification information in response to user activation of the content portion (paragraph [0039]), wherein the user identification includes a communication address where the user can receive communications from the direct marketing campaign via the wireless device(paragraphs [0022] and [0023]).

It should be noticed that Ferber fails to clearly teach the feature of registering the user in the identified direct marketing campaign in response to obtaining user identification information, as argued by the Applicants' in their remarks. However, Miller teaches such feature in col.6, line 43 – col.7, line 2 for a purpose of enjoying and receiving future incentives of such identified direct marketing campaign, i.e., the “outsite123.com”.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the feature of registering the user in the identified direct marketing campaign in response to obtaining user identification information, as taught by

Art Unit: 2643

Miller, into view of Ferber in order to directly offer to the registered cellular customers with future special incentives.

Regarding claims 6-8, Ferber further teaches limitations of the claims in paragraphs [0023] and [0025].

Regarding claim 9, Ferber teaches a direct marketing method for user of wireless devices, comprising: providing content within a display of a wireless device, wherein the content includes a portion that is responsive to user activation and that displays an identification of a direct marketing campaign, and wherein the content portion, responsive to user activation, is configured to register a user to receive one or more communications from the direct marketing campaign (paragraphs [0034] [0040]-[0041]); obtaining user identification information and direct marketing campaign identification information in response to user activation of the content portion (paragraph [0039]), wherein the user identification includes a communication address where the user can receive communications from the direct marketing campaign via the wireless device(paragraphs [0022] and [0023]).registering the user in the identified direct marketing campaign in response to obtaining user identification information; and means for sending a communication from the direct marketing campaign to the user at the communication address (paragraphs [0022] and [0023]).

It should be noticed that Ferber fails to clearly teach the features of registering the user in the identified direct marketing campaign in response to obtaining user identification information; and means for sending a communication from the direct marketing campaign to the user at the communication address, as argued by the Applicants' in their remarks. However, Miller teaches such feature in col.6, line 43 – col.7, line 2 for a purpose of enjoying and receiving future

Art Unit: 2643

incentives of such identified direct marketing campaign, i.e., the “outsitel23.com” and “\$10 off incentive”.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the feature of registering the user in the identified direct marketing campaign in response to obtaining user identification information, as taught by Miller, into view of Ferber in order to directly offer to the registered cellular customers with future special incentives.

Regarding claims 17-20, Ferber further teaches limitations of the claims in paragraphs [0023] and [0025].

Regarding claim 21, Ferber teaches a computer program product that registers wireless device users in a direct marketing campaign, the computer program product comprising a computer usable storage medium having computer readable program code embodied in the medium, the computer readable program code comprising: computer readable program code that provides content within a display of a wireless device, wherein the content includes a portion that is responsive to user activation and that displays an identification of a direct marketing campaign, and wherein the content portion, responsive to user activation, is configured to register a user to receive one or more communications from the direct marketing campaign (paragraphs [0034] [0040]-[0041]); and computer readable program code that obtains user identification information and direct marketing campaign identification information in response to user activation of the content portion (paragraph [0039]), wherein the user identification includes a communication address where the user can receive communications from the direct marketing campaign via the wireless device (paragraphs [0022] and [0023]).

It should be noticed that Ferber fails to clearly teach the feature of registering the user in the identified direct marketing campaign in response to obtaining user identification information, as argued by the Applicants' in their remarks. However, Miller teaches such feature in col.6, line 43 – col.7, line 2 for a purpose of enjoying and receiving future incentives of such identified direct marketing campaign, i.e., the “outsite123.com”.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the feature of registering the user in the identified direct marketing campaign in response to obtaining user identification information, as taught by Miller, into view of Ferber in order to directly offer to the registered cellular customers with future special incentives.

Regarding claims 26-28, Ferber further teaches limitations of the claims in paragraphs [0023] and [0025].

Regarding claim 29, Ferber teaches a direct marketing computer program product for uses of wireless devices, the computer program product comprising a computer usable storage medium having computer readable program code embodied in the medium, the computer readable program code comprising: computer readable program code that provides content within a display of a wireless device, wherein the content includes a portion that is responsive to user activation and that displays an identification of a direct marketing campaign, and wherein the content portion, responsive to user activation, is configured to register a user to receive one or more communications from the direct marketing campaign (paragraphs [0034] [0040]-[0041]); and computer readable program code that obtains user identification information and direct marketing campaign identification information in response to user activation of the content

Art Unit: 2643

portion (paragraph [0039]), wherein the user identification includes a communication address where the user can receive communications from the direct marketing campaign via the wireless device (paragraphs [0022] and [0023]).

It should be noticed that Ferber fails to clearly teach the features of registering the user in the identified direct marketing campaign in response to obtaining user identification information; and means for sending a communication from the direct marketing campaign to the user at the communication address, as argued by the Applicants' in their remarks. However, Miller teaches such feature in col.6, line 43 – col.7, line 2 for a purpose of enjoying and receiving future incentives of such identified direct marketing campaign, i.e., the “outsite123.com” and “\$10 off incentive”.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the feature of registering the user in the identified direct marketing campaign in response to obtaining user identification information, as taught by Miller, into view of Ferber in order to directly offer to the registered cellular customers with future special incentives.

Regarding claims 37-40, Ferber further teaches limitations of the claims in paragraphs [0023] and [0025].

Regarding claim 41, Ferber teaches a system that registers wireless device users in direct marketing campaigns, comprising: means for providing content within a display of a wireless device, wherein the content includes a portion that is responsive to user activation and that displays an identification of a direct marketing campaign, and wherein the content portion, responsive to user activation, is configured to register a user to receive one or more

Art Unit: 2643

communications from the direct marketing campaign (paragraphs [0034] [0040]-[0041]); and means for obtaining user identification information and direct marketing campaign identification information in response to user activation of the content portion (paragraph [0039]), wherein the user identification includes a communication address where the user can receive communications from the direct marketing campaign via the wireless device (paragraphs [0022] and [0023]).

It should be noticed that Ferber fails to clearly teach the feature of registering the user in the identified direct marketing campaign in response to obtaining user identification information, as argued by the Applicants' in their remarks. However, Miller teaches such feature in col.6, line 43 – col.7, line 2 for a purpose of enjoying and receiving future incentives of such identified direct marketing campaign, i.e., the “outsitel23.com”.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the feature of registering the user in the identified direct marketing campaign in response to obtaining user identification information, as taught by Miller, into view of Ferber in order to directly offer to the registered cellular customers with future special incentives.

Regarding claims 46-48, Ferber further teaches limitations of the claims in paragraphs [0023] and [0025].

Regarding claim 49, Ferber teaches a direct marketing system for users of wireless devices, comprising: means for providing content within a display of a wireless device, wherein the content includes a portion that is responsive to user activation and that displays an identification of a direct marketing campaign, and wherein the content portion, responsive to user activation, is configured to register a user to receive one or more communications from the

Art Unit: 2643

direct marketing campaign (paragraphs [0034] [0040]-[0041]); and means for obtaining user identification information and direct marketing campaign identification information in response to user activation of the content portion (paragraph [0039]), wherein the user identification includes a communication address where the user can receive communications from the direct marketing campaign via the wireless device (paragraphs [0022] and [0023]).

It should be noticed that Ferber fails to clearly teach the features of registering the user in the identified direct marketing campaign in response to obtaining user identification information; and means for sending a communication from the direct marketing campaign to the user at the communication address, as argued by the Applicants' in their remarks. However, Miller teaches such feature in col.6, line 43 – col.7, line 2 for a purpose of enjoying and receiving future incentives of such identified direct marketing campaign, i.e., the “outside123.com” and “\$10 off incentive”.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the feature of registering the user in the identified direct marketing campaign in response to obtaining user identification information, as taught by Miller, into view of Ferber in order to directly offer to the registered cellular customers with future special incentives.

Regarding claims 57-60, Ferber further teaches limitations of the claims in paragraphs [0023] and [0025].

5. Claims 2-5, 11-16, 22-25, 31-36, 42-45 and 51-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferber (Pub. No.: US 2001/0032193 A1) in view of Miller (US Pat. #:

Art Unit: 2643

6,882,977) as applied to claims 1, 9, 21, 29, 41 and 49 above, and further in view of Angles et al. (U.S. Pat. #: 5,933,811 *also cited in the previous Office Action*).

Regarding claims 2, 11-12, 22, 31-32, 42 and 51-52, Ferber and Miller, in combination, teaches all subject matters as claimed above, except the feature of extracting user identification information from an HTTP header associated with a user request generated in response to user activation of the content portion. However, Angles et al. ("Angles") teaches an interactive communication device using Hypertext Transport Protocol (HTTP) for the exchange of information such as HyperText Markup Language (HTML) wherein the HTML including consumer information as user identification extracted and stored in a database such as registration database 68(col.6, lines 32-58 and col.17, lines 3-30) for purpose of directly transmitting advertised messages to registered consumer in a future.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use of said feature of extracting user identification information from an HTTP header associated with a user request generated in response to user activation of the content portion, as taught by Angles, into view of Ferber and Miller in order to directly provide advertisement messages to registered users in the future.

Regarding claims 3, 13-14, 23, 33-34, 43 and 53-54, Angles further teaches limitations of the claim in col.15, lines 3-31.

Regarding claims 4-5, 15-16, 24-25, 35-36, 44-45 and 55-56, Angles further teaches limitations of the claims in col.15, lines 43-55 and col.16, line 56 through col.17, line 10.

Art Unit: 2643

6. Claims 10, 30 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferber (Pub. No.: US 2001/0032193 A1) in view of Miller (US Pat. #: 6,882,977) as applied to claims 1, 9, 21, 29, 41 and 49 above, and further in view of Taniguchi et al. (Pub. No.: US 2002/0065748 A1 *also cited in the previous Office Action*).

Regarding claims 10, 30, 50, Ferber and Miller, in combination, teaches all subject matters as claimed above, except the feature of unregistering the user from receiving advertisements from a direct marketing campaign. However, Taniguchi et al. ("Taniguchi") teaches such well-known feature in paragraph [0014] for a purpose of preventing user receipts of unwanted advertisement messages.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use of said feature of unregistering the user from receiving advertisements from a direct marketing campaign, as taught by Taniguchi, into view of Ferber and Miller in order to eliminate receipts of unwanted advertisement messages from marketing campaigns.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (571) 272-7510 and E-mail address: BINH.TIEU@USPTO.GOV.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (571) 272-7499 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

Art Unit: 2643

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

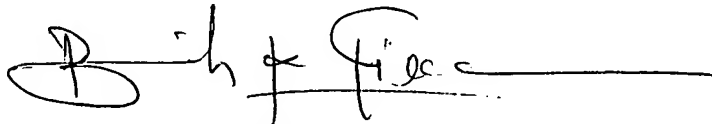
Or faxed to:

(571) 273-8300

Hand Carry Deliveries to:

Customer Service Window
(Randolph Building)
401 Dulany Street
Alexandria, VA 22314

In formation regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the FAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Binh Tieu', with a long horizontal line extending to the right.

BINH TIEU
PRIMARY EXAMINER

Art Unit 2643

Date: March 17, 2006